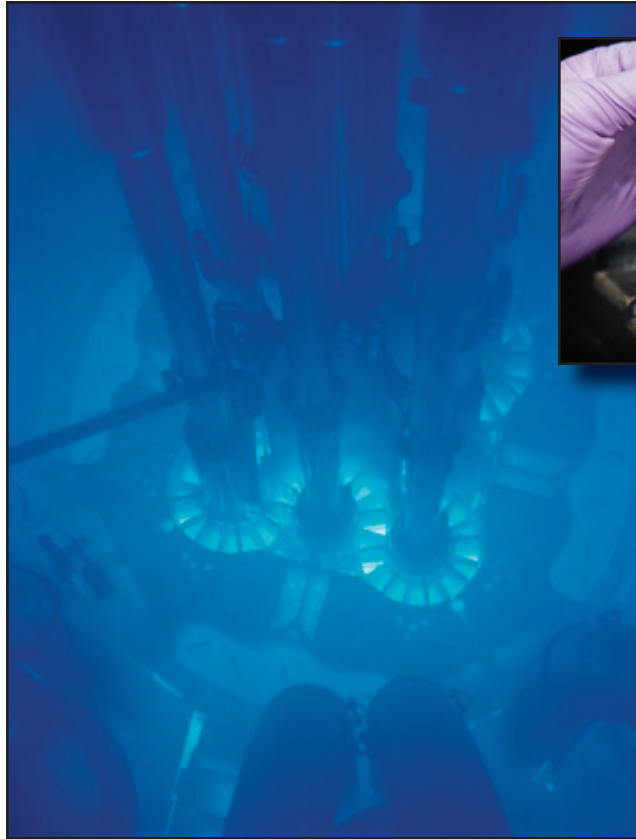


INL Technology Licensing

What to Expect



License agreements between Battelle Energy Alliance (BEA), the Management and Operating Contractor at the Idaho National Laboratory (INL) and a business (or other entity) allow the business to reproduce, manufacture, sell, or use INL-developed or owned intellectual property. INL contractor-owned inventions are available for licensing for commercialization by U.S. and foreign companies

and organizations. The INL licenses its intellectual property on much of the same terms as universities, other research organizations and industrial firms.

Grant of Rights: Various licensing terms may be negotiated, including both exclusive and non-exclusive license grants. Exclusive licenses may be in certain fields of use, geographic areas, or according to other terms. Co-exclusive and

partially exclusive licenses, where exclusive rights to commercialize a technology may be shared by several organizations or restricted by area of use, territory or other terms, may also be granted. For example, one company may obtain exclusive rights to use and invention for applications in the energy industry while another exclusively licenses the same invention for applications in the food industry.

Contact:

Technology Transfer & Commercialization

Ray Barnes
208.526.1127
ray.barnes@inl.gov

www.inl.gov



Royalties and Payments: INL licensing royalties comparable to those charged by universities, other research organizations and the private sector. Licenses usually require an up-front, nonrefundable payment, royalty payments based on sales, and a minimum annual royalty. The fees will vary depending on the number of patents licensed, the demand for the technology, and the exclusivity of the license. Licensees obtaining foreign rights may be asked to pay the cost of preparing, filing, and prosecuting foreign patent applications, and the maintenance of all resulting foreign patents.

U.S. Government

Retained License: As with all technology developed with federal funds, the U.S. Government retains a worldwide, non-exclusive, nontransferable, irrevocable, paid-up license to practice or have practiced any licensed intellectual property for or on behalf of the U.S. Government.

U.S. Preference: INL is required to preferentially license inventions to U.S.-based firms, particularly those that will develop and manufacture licensed products in the U.S. However, in appropriate circumstances, non-U.S. firms may receive licenses, including broad exclusive

licenses, for the countries in which they operate or even receive exclusive worldwide licenses.

Technical Assistance:

The Licensee is solely responsible for the commercialization of the licensed inventions. Under specific circumstances, INL may agree to provide technical assistance to the Licensee on a full cost recovery basis if the work is beneficial to the INL's mission objectives.

Limited Warranty and

Indemnification: Any license for INL technology will contain a disclaimer of warranties and require indemnification of BEA and the U.S. Government.

Non-Assignability: The license may extend to subsidiaries of the licensee or other parties, if provided for in the license, but will be non-assignable unless approved by the INL, except to the successor of that part of the licensee's business to which the invention pertains.

Sublicensing: An INL license may include the right to grant sublicenses under the license, subject to the approval of the INL. Each sublicense shall make reference to the license, including the rights retained by the Government, and a copy of such sublicense

must be furnished to the INL.

DOE March-in Rights:

The DOE has certain march-in rights to intellectual property developed with federal funding. Although rarely exercised, this right is in accordance with the Code of Federal Regulations.

Export Control: The license will contain a provision recognizing that the export of goods and/or technical data from the U.S. may require an export license from the U.S. Government. Failure to obtain an export license may result in criminal liability under U.S. law.